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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/688,983
Filing Date: October 17, 2000
Appellant(s): EDER, JEFF S.

BJ Bennett
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 4/30/2007 appealing from the Office action mailed 1/3/2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The following are the related appeals, interferences, and judicial proceedings known to the examiner which may be related to, directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal:

09/761,671, 10/329,172 and 10/282,113, 09/940,450

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

6,671,673 Baseman et al.

US 6,836,773	Tamayo et al.
US 6,078,901	Ching
US 7,006,992	Packwood
US 6,301,584	Ranger

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 157-181 and 201-213, are rejected under 35 U.S.C. § 101 because the claimed invention is directed to a non-statutory subject matter.

Claims 157-181 and 201-213 do not produce a "concrete" result in the "A computer readable medium having sequences of instructions stored therein, which when executed cause the processor in a computer to perform a risk management optimization method" and "An advanced management method". The claims are directed to measuring risks using different known economical factors. The results (optimizing) in the present application do not produce concrete results. It is unclear how the present

application expresses how the resulting optimization is being applied to risk management, and how is it used in representing such elements as: brand, customer relationship, employee relationship, alliance, etc which are not quantifiable. For example, is brand or market sentiment quantifiable? if so, is it repeatable?

The results of applicant's invention in arriving at a probable success factor is clearly not the same results found in State Street Bank & Trust Co. V. Signature Financial group, Inc., 149 F 3d 1371; 47 USPQ 2d 1599 decided by the U.S. Courts of Appeals. "Today we hold the transformation of data representing discrete dollar amounts by a machine through a series of mathematical calculations into a final share price constitutes a practical application of a mathematical algorithm, formula or calculation because it produces a useful, concrete and tangible result, a final share price momentarily fixed for recording and reporting purposes". In the State Street case the "concrete, tangible, and useful results" is allocating money to different funds.

In the AT&T v. Excel Communications the useful, concrete, and tangible results is the claimed step of "producing message record for long distance telephone calls, enhanced by addition of Primary Interexchange Carrier (PIC) indicator". The system performs different calculations and the result facilitates differential billing of calls made by the subscriber to long distance service carrier.

In the present application, the disclosure is nothing more than generalities as to various risks and assessing and categorizing various risk factors. However, the disclosure is short on specifics as to explicitly how certain risk factors are determined. Specification lists numerous factors but there appears to be so many variables and

subjective determinations to be made at each step of the calculation system.

Furthermore, it is unclear from the disclosure how the computer would be programmed in order to take into account all of these subjective risks factors for calculating the risks and optimization **Although the instant** specification is replete with generalizations regarding the various factors to be taken into consideration, it is short on any specific direction or guidance as to actually gathering the necessary data, inputting the required data and programming a computer to achieve the desired results. Further, the specification lacks guidance as to how the resulting optimization is being applied in every case and combination. There is no indication in the specification of how the composite factors (elements) are used (picked by trial, error and/or emotion) to evaluate the risk/strength of a specific intellectual property, brand, etc. A manipulation of risk factors, without affecting the result of actual determination of optimization, is not of itself patentable.

Therefore, it is clear from the definition of "concrete" and the analysis of the disclosed elements (Brand, sentiment value, etc) and the claimed limitations of the present invention mentioned above that the disclosure of the present invention is nothing more than generalizations regarding the various factors to be taken into consideration, and it is short on any particular or specific direction or guidance in achieving the desired results and in providing a concrete result which should be repeatable. Consequently, the claims are analyzed based upon the underlying process and thus rejected as being directed to a non-statutory process.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 157-181 and 201-213 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or Use the invention.

In particular, the disclosure is nothing more than generalities as to various risks and assessing and categorizing various risk factors. Various factors are combined to optimize risk management without providing systematic means to achieve risk management optimization. In the present application, the disclosure is nothing more than generalities as to various risks and assessing and categorizing various risk factors. However, the disclosure is short on specifics as to explicitly how certain risk factors are determined. The specification lists numerous factors, but there appears to be so many variables and subjective determinations to be made at each step of the calculation system. **Furthermore,** it is unclear from the disclosure how the computer would be programmed, without undue experimentation, to convert text and essay questions and responses into computer data and in order to take into account all of these subjective risk factors, which the calculation process appears to entail. **Although the instant** specification is replete with generalizations regarding the various factors to be taken into

consideration, it is short on any specific direction or guidance as to actually gathering the necessary data, inputting the required data and programming a computer to achieve the desired results. Further, the specification lacks guidance as to how to use the optimization in every case and combined. There is no indication in the specification of how the composite factors (elements) are used (picked by trial, error and/or emotion) to evaluate the strength of a specific intellectual property, brand, etc. A manipulation of risk factors, without the means to effect the actual determination of optimization, is not of itself patentable. There is no indication in the specification of how the elements are combined for evaluation of risks, the elements are randomly picked if so they are repeatable.

Applicant's specification does not explain: How to measure plurality of risks? Identifying one or more risk management activities based upon said risks and calculating an amount of capital available for said risk management activities using at least a portion of said data. Explain how optimization is done. How market value is computed. Also where in specification quantifying risk under scenarios ... is explained? What is normal and extreme scenario? Is it simply arbitrary assumption of historical risk verse an impact of unforeseen event? How it is quantified? Where in the specification is learning being explained. How does the system learns? How the enterprise value and risks are quantified? Applicant is requested to provide clear explanations how these activities are performed and to clearly point out where in specification these limitations are defined or described. Examples will help examiner to better understand the

applicant's invention and focus on relevant search. Applicant's specification doe not provide clear description how the invention is exercised.

Claim Objections

3. Claims 212-213 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claims 212 and 213 are improper dependent claims, the claims are dependent on claim 214, which is not claimed (does not exist).

Double Patenting

4. Claim 211 is objected to under 37 CFR 1.75 as being a substantial duplicate of claim 204. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 157, 159-163, 165-167, 169, 171-176, 178-180 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baseman et al. (hereinafter Baseman – US 6,671,673) in view of Tamayo et al. (hereinafter Tamayo – US 6,836,773).

Re. Claim 157, Baseman discloses Baseman measuring a plurality of risks using at least a portion of said data [Abstract; col. 1 lines 7-10, 25-30 (various performance measures); col. 6 lines 22-33];

identifying one or more risk management activities based upon said risks [col. 6 lines 22-33; col. 14 lines 37-49];

calculating an amount of capital available for said risk management activities using at least a portion of said data [col. 2 line 49 to col. 3 line 18, 35-45 (investment planning, budgets, hedging); col. 8 lines 9-15; col. 11 lines 32-33 (investment analysis)]; and,

determining a combination of risk management activities that optimizes aspects of enterprise financial performance selected from the group consisting of market value, risk and combinations thereof within a constraint of the available capital [col. 11 lines 17-40; col. 27 lines 17-32, 58-63; col. 28 lines 16-25 (risk) (maximize shareholder value)].

Baseman does not explicitly disclose preparing data from a plurality of enterprise transaction systems for use in processing.

Tamayo discloses preparing data from a plurality of enterprise transaction systems for use in processing [col.1 lines 37-47; col. 2 line 8-12, 22-24] to automatically

collect and integrate data from different sources to be use in process of generating prediction or recommendation cost effectively (col. 3 line 10). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Baseman and include preparing data from a plurality of enterprise transaction systems for use in processing, as discloses by Tamayo, to collect data form enterprise wide system and format (prepare) different types for addressing risk management.

Re. Claim 159, Baseman discloses wherein a market value further comprises one or more categories of value selected from the group consisting of an current operation, real option, market sentiment and combinations thereof [col. 5 lines 32-41].

Re. Claims 160-162, Baseman discloses wherein a risk management activity is selected from the group consisting of establishing one or more risk management control systems, completing one or more risk transfer transactions and combinations thereof [col. 6 lines 22-40; col.7lines 20-33], wherein establishing each of one or more risk management control systems further comprises identifying a risk reduction activity and optionally establishing a method for implementing said activity in an automated fashion [col. 10 lines 12-43], and wherein completing one or more risk transfer transactions further comprises completing activities selected from the group consisting of insurance purchases, derivate transactions, and combinations thereof [col. 5 lines 32-55; col. 15

lines 6-14 (options = financial instrument) insurance and underwriting are known for transfer of risks].

Re. Claim 163, Baseman discloses developing a computational model of organization market value by category of value, element of value and external factor by completing a series of multivariate analyses in an automated fashion using at least a portion of the data, and *quantif*ying a plurality of risks by a category of value using said model, where a category of value is selected from the group consisting of current operation, real option, market sentiment and combinations thereof [B – col. 17 lines 35-38; col. 8 lines 16-27; [B – col. 17 lines 35-38; col. 8 lines 16-27 and see supra].

Re. Claim 165, Baseman discloses an optimization of aspects of financial performance selected from the group consisting of current operation value, real option value, market sentiment value and combinations thereof [col. 1 lines 25-38;col. 3 lines 35-40].

Re. Claim 166, Baseman discloses determining an optimal combination of risk management activities further comprises using a method selected from the group consisting of quasi Monte Carlo, genetic algorithm, multi-criteria optimization and linear programming [col. 8 lines 16-42].

Re. Claim 167, Basemane discloses using one or more shadow prices from a linear programming optimization calculation to identify an optimal budget for risk management activities [col. 12 lines 30-51].

Re. Claim 169, Baseman discloses Baseman measure a plurality of risks using at least a portion of said data [Abstract; col. 1 lines 7-10, 25-30 (various performance measures); col. 6 lines 22-33],

identify one or more risk management activities based upon said risks [col. 17 lines 35-38; col. 8 lines 16-27 and supra];

calculate an amount of capital available for said risk management activities using at least a portion of said data [col. 2 line 49 to col. 3 line 18, 35-45 (investment planning, budgets, hedging); col. 8 lines 9-15; col. 11 lines 32-33 (investment analysis)], and

determine a combination of risk management activities that optimizes aspects of enterprise financial performance selected from the group consisting of market value, risk and combinations thereof within one or more constraints of the available capital [col. 11 lines 17-40; col. 27 lines 17-32, 58-63; col. 28 lines 16-25 (risk) (maximize shareholder value)].

Baseman does not explicitly disclose networked computers each with a processor having circuitry to execute instructions, a storage device available to each processor with sequences of instructions stored therein, which when executed cause the processors to, prepare data from a plurality of enterprise transaction systems for use in processing. Tamayo discloses networked computers each with a processor

having circuitry to execute instructions [col. 5 lines 7-11; col. 6 line 50 to col. 7 line 3], a storage device available to each processor with sequences of instructions stored therein, which when executed cause the processors to [col. 7 lines 4-27],

prepare data from a plurality of enterprise transaction systems for use in processing [col. 2 lines 4-9; 22-24] to automatically collect and integrate data from different sources to be use in process of generating prediction or recommendation cost effectively. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Baseman and include preparing data from a plurality of enterprise transaction systems for use in processing, as discloses by Tamayo, to collect data form enterprise wide system and format (prepare) different types for addressing risk management.

Re. Claim 171, Baseman wherein a market value further comprises one or more categories of value selected from the group consisting of an current operation, real option, market sentiment and combinations thereof [col. 5 lines 32-41].

Re. Claims 172-174, Baseman discloses wherein a risk management activity is selected from the group consisting of establishing one or more risk management control systems, completing one or more risk transfer transactions and combinations thereof [col. 6 lines 22-40; col.7lines 20-33], wherein establishing each of one or more risk management control systems further comprises identifying a risk reduction activity and optionally establishing a method for implementing said activity in an automated fashion

[col. 10 lines 12-43] and wherein completing one or more risk transfer transactions further comprises completing activities selected from the group consisting of insurance purchases, derivate transactions, and combinations thereof [col. 5 lines 32-55; col. 15 lines 6-14 (options = financial instrument) insurance and underwriting are known for transfer of risks].

Re. Claim 175, Baseman discloses developing a computational model of organization market value by category of value, element of value and external factor by completing a series of multivariate analyses in an automated fashion using composite applications and at least a portion of the data, and *quantif*ying a plurality of risks by a category of value using said model, where a category of value is selected from the group consisting of current operation, real option, market sentiment and combinations thereof [col. 17 lines 35-38; col. 8 lines 16-27; [col. 17 lines 35-38; col. 8 lines 16-27 and see supra].

Re. Claim 176, Baseman discloses wherein a series of multivariate analyses are selected from the group consisting of identifying one or more previously unknown item performance indicators, discovering one or more previously unknown value drivers, identifying one or more previously unknown relationships between one or more value drivers, identifying one or more previously unknown relationships between one or more elements of value, *quantif*ying one or more inter relationships between value drivers, *quantif*ying one or more impacts between elements of value, developing one or more composite variables, developing one or more vectors, developing one or more causal

element impact summaries, identifying a best fit combination of predictive model algorithm and element impact summaries for modeling enterprise market value and each of the components of value, building predictive models using transaction data, determining a net element of value impact for each category of value, determining a relative strength of the elements of value between two or more enterprises, developing one or more real option discount rates, calculating one or more real option values, calculating an enterprise market sentiment value by element, developing a covariance matrix, developing a series of scenarios, simulating a financial performance under a given scenario and combinations thereof [col. 13 lines 12-40; col. 20 lines 1-36; col. 25 lines 41-53; col. 27 line 58 to col. 28 line 15].

Re. Claim 178, Baseman discloses an optimization of aspects of financial performance selected from the group consisting of current operation value, real option value, market sentiment value and combinations thereof [col. 17 lines 35-38; col. 8 lines 16-27; [B – col. 17 lines 35-38; col. 8 lines 16-27 and see supra].

Re. Claim 179, Baseman discloses where determining an optimal combination of risk management activities further comprises using a method selected from the group consisting of quasi Monte Carlo, genetic algorithm, multi-criteria optimization and linear programming [col. 8 lines 16-42].

Re. Claim 180, Baseman discloses using one or more shadow prices from a linear programming optimization calculation to identify an optimal budget for risk management activities [col. 12 lines 30-51].

Claims 201-202, 204, 207, 209, 211 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baseman in view of Tamayo and Ching (US 6,078,901).

Re. Claim 201, Baseman discloses *quantify* a tangible impact for a plurality of risks [col. 6 lines 22-33; col. 11 lines 17-40; col. 5 lines 32-41].

Tamayo discloses aggregating and preparing data from a plurality of enterprise related systems for use in processing [col. 1 lines 37-47; col. 2 lines 2-5, 22-24], and leaning from at least a portion of the data [col. 8 line 65 to col. 9 line 2; col. 21 lines 46-55; col. 22 lines13-17; col. 23 lines 49-60] to incrementally build on top of data stream and adopt better trends and changing conditions. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Baseman and include preparing data from a plurality of enterprise transaction systems for use in processing, as discloses by Tamayo, to collect data form enterprise wide system and format (prepare) different types for addressing risk management and incrementally build on top of data stream and adopt better trends and changing conditions for addressing risk.

Ching discloses one or more elements of value on one or more subsets of value selected from the group consisting of a category of value, a component of value and

combinations thereof where one or more elements of value are selected from the group consisting of alliances, brands, customers, customer relationships, employees, employee relationships, infrastructure, intellectual property, information technology, partnerships, processes, production equipment, vendors, vendor relationships and combinations thereof, and where a plurality of risks are selected from the group consisting of event risks, contingent liabilities, volatility and combinations thereof [col. 13 lines 20 to col. 18 (see categories - intellectual property, balance sheet, copyright), options on future contracts, option theory, risk, risk assessment); col. 40 lines 11-19; col. 29 lines 59-60] to drive value based on deterministic solution and mathematical relations between all the market factors and economically reasonable inputs (col. 11). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Baseman and Tamayo and include the above elements of value (all economical reasonable inputs), as disclosed by Ching, to drive value based on deterministic solution and mathematical relations between all the market factors and economically reasonable inputs.

Re. Claim 202, Baseman discloses identifying one or more risk management activities based upon one or more *quantified* risks [col. 6 lines 22-33; col. 14 lines 37-49], calculating an amount of capital available for said risk management activities using at least a portion of said data [col. 2 line 49 to col. 3 line 18, 35-45 (investment planning, budgets, hedging); col. 8 lines 9-15; col. 11 lines 32-33], and

determining a combination of risk management activities that optimizes aspects of enterprise financial performance selected from the group consisting of market value, risk and combinations thereof within a constraint of the available capital [col. 11 lines 17-40; col. 27 lines 17-32, 58-63; col. 28 lines 16-25 (risk) (maximize shareholder value)].

Re. Claim 204, Baseman discloses wherein a category of value is selected from the group consisting of current operation, real option, market sentiment and combinations thereof and a component of value is selected from the group consisting of revenue, expense, capital and combinations thereof [col. 5 lines 32-41, see supra].

Re. Claim 207, Baseman discloses analyzing at least a portion of the data as required to *quantify* an enterprise value and risk [col. 17 lines 35-38; col. 8 lines 16-27; [B – col. 17 lines 35-38; col. 8 lines 16-27 and see supra]. Tamayo discloses aggregating and preparing data from a plurality of enterprise related systems for use in processing [col. 1 lines 37-47; col. 2 lines 2-5, 22-24] to automatically collect and integrate data from different sources to be use in process of generating prediction or recommendation cost effectively (col. 3 line 10). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Baseman and include preparing data from a plurality of enterprise transaction systems for use in processing, as discloses by Tamayo, to collect data form enterprise wide system and format (prepare) different types for addressing risk management.

Ching discloses by one or more subsets of value selected from the group consisting of a category of value, a component of value, an element of value and combinations thereof where an element of value is selected from the group consisting of alliances, brands, customers, customer relationships, employees, employee relationships, Infrastructure, intellectual property, information technology, partnerships, processes, production equipment, vendors, vendor relationships and combinations thereof,
where an enterprise value further comprises a market value, and
where an enterprise risk further comprises a sum of a plurality of risks selected from the group consisting of event risks, contingent liabilities, volatility and combinations thereof [col. 13 lines 20 to col. 18 (see categories - intellectual property, balance sheet, copyright), options on future contracts, option theory, risk, risk assessment); col. 40 lines 11-19; col. 29 lines 59-60] to drive value based on deterministic solution and mathematical relations between all the market factors and economically reasonable inputs (col. 11). It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Baseman and Tamayo and include the above elements of value (all economical reasonable inputs), as disclosed by Ching, to drive value based on deterministic solution and mathematical relations between all the market factors and economically reasonable inputs.

Re. Claim 209, Baseman discloses identifying one or more risk management activities based upon one or more *quantified* risks [col. 6 lines 22-33; col. 14 lines 37-49];

calculating an amount of capital available for said risk management activities using at least a portion of said data [col. 2 line 49 to col. 3 line 18, 35-45 (investment planning, budgets, hedging); col. 8 lines 9-15; col. 11 lines 32-33 – see supra];

and

determining a combination of risk management activities that optimizes aspects of enterprise financial performance selected from the group consisting of market value, risk and combinations thereof within a constraint of the available capital [col. 11 lines 17-40; col. 27 lines 17-32, 58-63; col. 28 lines 16-25 (risk) (maximize shareholder value)].

Re. Claim 211, Baseman discloses wherein a category of value is selected from the group consisting of current operation, real option, market sentiment and combinations thereof and a component of value is selected from the group consisting of revenue, expense, capital and combinations thereof [col. 5 lines 32-41, see supra].

Claims 158, 164, 170, 177, are rejected under 35 U.S.C. 103(a) as being unpatentable over Baseman and Tamayo, as applied to claims 157, 163, 169 above, and further in view of Packwood (US 7,006,992).

Re. Claim 158, Packwood discloses *quantif*ying risks under scenarios selected from the group consisting of normal (acceptable), extreme (unacceptable) and combinations

thereof [Abstract; col. 1 lines 25-31, 45-46 ("different risks to a business); col. 5 lines 56-62 and example]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Baseman, Tamayo and include the above feature, as disclosed by Packwood, to identify a series of predetermined risk factors which are quantified with a measurable characteristic.

Re. Claim 164, Packwood discloses wherein the method further comprises *quantif*ying risk by element of value and external factor where the elements of value are selected from the group consisting .of alliances, brands, customers, customer relationships, employees, employee relationships, infrastructure, intellectual property, information technology, partnerships, processes, production equipment, vendors, vendor relationships and combinations thereof [Abstract; col. 1 lines 25-31, 45-46 ("different risks to a business); col. 5 lines 56-62 and example]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Baseman, Tamayo and include the above feature, as disclosed by Packwood, to identify a series of predetermined risk factors which are quantified with a measurable characteristic.

Re. Claim 170, Packwood discloses wherein measuring a plurality of risks further comprises *quantif*ying risks under scenarios selected from the group consisting of normal, extreme and combinations thereof [Abstract; col. 1 lines 25-31, 45-46 ("different risks to a business); col. 5 lines 56-62 and example]. It would have been obvious at the

time the invention was made to a person having ordinary skill in the art to modify the disclosure of Baseman, Tamayo and include the above feature, as disclosed by Packwood, to identify a series of predetermined risk factors which are quantified with a measurable characteristic.

Re. Claim 177, Packwood discloses wherein the method further comprises *quantif*ying risk by element of value and external factor where the elements of value are selected from the group consisting of alliances, brands, customers, customer relationships, employees, employee relationships, infrastructure, Intellectual property, information technology, partnerships, processes, production equipment, vendors, vendor relationships and combinations thereof [Abstract; col. 1 lines 25-31, 45-46 ("different risks to a business); col. 5 lines 56-62 and example]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Baseman, Tamayo and include the above feature, as disclosed by Packwood, to identify a series of predetermined risk factors which are quantified with a measurable characteristic.

Claims 205, 210 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baseman, Tamayo, and Ching as applied to claims 201, 207 above, and further in view of Packwood.

Re. Claim 205, Packwood discloses wherein *quantif*ying a plurality of risks further comprises *quantif*ying risks under scenarios selected from the group consisting of normal, extreme and combinations thereof [Abstract; col. 1 lines 25-31, 45-46 ("different risks to a business); col. 5 lines 56-62 and example]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosure of Baseman, Tamayo, Ching and include the above feature, as disclosed by Packwood, to identify a series of predetermined risk factors which are quantified with a measurable characteristic.

Re. Claim 210, Packwood discloses wherein *quantif*ying an impact for plurality of risks further comprises *quantif*ying an impact for a plurality of risks under scenarios selected from the group consisting of normal, extreme and combinations thereof [Abstract; col. 1 lines 25-31, 45-46 ("different risks to a business); col. 5 lines 56-62 and example]. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to modify the disclosures of Baseman, Tamayo, Ching and include the above feature, as disclosed by Packwood, to identify a series of predetermined risk factors which are quantified with a measurable characteristic.

Claims 168, 181 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baseman and Tamayo, as applied to claim 157, 169 above, and further in view of Ranger (US 6,301,584).

Re. Claim 168, Ranger discloses using metadata mapping to convert, integrate and store a plurality of enterprise related data from a plurality of enterprise related systems in accordance with a metadata standard where a metadata standard is selected from the group consisting of xml and metadata coalition specification and a metadata mapping table is used to support the integration, conversion and storage of data [col. 3 lines 30-38; col. 5 line 42 to col. 6 line 23; col. 10 lines 1-40; col. 12 line 59 to col. 13 line 5] to collect relevant information located at a *plurality* of sites and stored in *plurality* of incompatible formats according to configurable search strategies. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Baseman and Tamayo and Ranger and include using metadata mapping to extract data from data sources and integrate into a model and present to the user in improved and different format.

Re. Claim 181, Ranger discloses converting and storing a plurality of enterprise related data from a plurality of enterprise related systems in accordance with an xml or metadata coalition metadata standard [col. 3 lines 30-38; col. 5 line 42 to col. 6 line 23; col. 10 lines 1-40; col. 12 line 59 to col. 13 line 5] to collect relevant information located at a *plurality* of sites and stored in *plurality* of incompatible formats according to configurable search strategies. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Baseman and Tamayo and Ranger and include using metadata mapping to extract data from data

sources and integrate into a model and present to the user in improved and different format.

Claims 203, 206, 208 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baseman and Tamayo, as applied to claim 201, 207, above, and further in view of Ranger (US 6,301,584).

Re. Claim 203, Ranger discloses wherein aggregating and preparing data from a plurality of enterprise related systems for use in processing, further comprises using metadata mapping to integrate and store data from said systems in accordance with a common schema [col. 3 lines 30-38; col. 5 line 42 to col. 6 line 23; col. 10 lines 1-40; col. 12 line 59 to col. 13 line 5] to collect relevant information located at a *plurality* of sites and stored in *plurality* of incompatible formats according to configurable search strategies. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Baseman, Tamayo, Ching and Ranger and include using metadata mapping to extract data from data sources and integrate into a model and present to the user in improved and different format.

Re. Claim 208, Ranger discloses wherein aggregating and preparing data from a plurality of enterprise related systems for use in processing, further comprises using metadata mapping to integrate, convert and store date from said systems in accordance

with a common schema [col. 3 lines 30-38; col. 5 line 42 to col. 6 line 23; col. 10 lines 1-40; col. 12 line 59 to col. 13 line 5] to collect relevant information located at a *plurality* of sites and stored in *plurality* of incompatible formats according to configurable search strategies. It would have been obvious at the time the invention was made to a person having ordinary skill in the art to combine the disclosures of Baseman, Tamayo, Ching and Ranger and include using metadata mapping to extract data from data sources and integrate into a model and present to the user in improved and different format.

Re. Claim 206, Baseman discloses wherein a risk management activity is selected from the group consisting of establishing one or more risk management control systems, completing one or more risk transfer transactions and combinations thereof [col. 6 lines 22-40; col.7 lines 20-33].

(10) Response to Argument

Appellant provided different scenarios why the prior arts cannot be combined. 1). Appellant asserts that Baseman teaches a method for developing an optimization plan for enterprise profit that relies on the assumption that optimized results can be obtained after making changes to the enterprise supply chain and related variables. Tamayo teaches a method for improving web site visitor experience that relies exclusively on analyzing Internet visitor data.

Examiner analysis of the prior art with respect to the claimed limitations, with broadest interpretation of claimed limitations, are stated in the office action (paper number 20061218), further:

Baseman teaches a method to generate a strategic business plan to improve operations, and to closely monitor various performance measures of an entire enterprise using software tool and data required to manipulate (by using a constrained mathematical model with this trade-off and investment analysis, including analysis of portfolio investments, foreign direct investments, capital budgeting) to maximize shareholder value or value of the firm (see abstract and col. 6. lines 1-32; col. 8 lines 3-15; col. 11 lines 32-34).

Secondary reference, Tamayo teaches data mining An enterprise-wide web data mining system, software and method of operation using Internet based data sources, receive a request for a prediction or recommendation, generate a prediction or recommendation, and transmit the generated prediction or recommendation (abstract), additionally Tamayo teaches obtaining data from plurality of data sources (including external data) and preprocessing data (col. 2 lines 1-20). Prior art (Tamayo) teaches functions and ability of a system for collecting and processing data enterprise data from plurality of resources which enables Baseman to utilize functions and tools provided by Tamayo for collecting and preparing enterprise data for its analysis of creating enterprise value (value of the firm).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by

combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). in this case collect and integrate data from different sources to be use in process of generating prediction (value of the firm) or recommendation cost effectively (see paper number 20061218 - page 9 lines 16-18 and page 10 lines 2-4).

Examiner would like to point out that a proper combination under 35 U.S.C. 103 does not require bodily incorporation of the teaching of one reference into another, paying no attention to what the artisan of ordinary skill would consider in making the combination. See In re Keller, 642 F.2d 413,208 USPQ 871 (CCPA 1981).

Secondary reference, Ching teaches calculating devices for non-arbitrary price and value determination and rational decision making (abstract; col. 1 lines 18-22), calculating of the return on investment especially intellectual properties (or element of value) (see col. 13 lines 6-21). Teaching of Ching can be combined with teaching of Baseman and Tamayo to calculate and account for element of value such as intangible factors (intellectual properties: patents, brand, & trade mark) which contribute to the value of the firm (value of enterprise). In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation

to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case drive value based on deterministic solution and mathematical relations between all the market factors and economically reasonable inputs (see paper number 20061218 - page 17 lines 6-7 and 11-12).

Secondary reference, Packwood teaches a method of analyzing and presenting a series of risk factors associated with the operation of a business. Further, Packwood teaches quantifiable risk factors and ranges of acceptable
and unacceptable values for the factors, where each risk factor has an immediacy value, or risk tolerance, assigned to it (abstract; col. 1 lines 25-31, col. 5 lines 56-62). Teaching of Packwood can be combined with teaching of Baseman and Tamayo (Baseman, Tamayo and Ching) to analyze value of a firm with different range and level of risks including acceptable measured value or unacceptable values with different tolerance which has impact on the value of the firm. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case identify a series of predetermined risk factors which are

quantified with a measurable characteristic (paper number 20061218 - page 20 lines 18-19).

Secondary reference, Ranger teaches a data integration system and method gathers information dynamically from one or more data sources, which may be located at different servers and have incompatible formats, structures the information into a configurable, object oriented information model, and outputs the information for the user according to an associated, configurable visual representation with automatic content classification and metadata to generically organize information about specific information models and implementation of metadata with rational database (abstract; col. 2 lines 15-24; col. 5 lines 42-50). Teaching of Ranger can be combined with teaching of Baseman and Tamayo to provide an integration method for collecting relevant data for different sites and converting different data type to standard metadata for compatibility with other data in order to use different data type for analysis of value of the firm. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case to collect relevant information located at a *plurality* of sites and stored in *plurality* of incompatible formats

according to configurable search strategies (paper number 20061218 - page 24 lines 3-4).

In response to Appellant's comment regarding declaration under rule 132, submitted along with appeal brief is not considered and advisory has been mailed to Applicant.

IDS submitted after paper number 20061218 are considered.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Harish T. Dass Harish T Dass
Examiner
Art Unit 3693

Conferees:

Vincent Millin

James Kramer (SPE 3693)